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7590

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EXAMINER

ROWE, JESSE C

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 07/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/973,109

Applicant(s)

GREENWALD ET AL.

Examiner

Jesse C Rowe

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10/09/2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 9-11 and 21-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25-29 is/are allowed.
- 6) ☒ Claim(s) 9-11, 23, 24, 30, 34 and 35 is/are rejected.
- 7) ☒ Claim(s) 21, 22 and 31-33 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/09/01 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 2872

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the mesh and membrane as claimed in claims 23-24, 28-29 and 34-35 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Information Disclosure Statement***

The information disclosure statement filed Jan. 22, 2002 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. *The elements listed thru have not been considered.* ~~It has been placed in the application file, but the information referred to therein has not been considered.~~

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 30 rejected under 35 U.S.C. 102(b) as being anticipated by Henry. Henry discloses a method imaging excised tissue comprising the steps of providing a container (22 and

Art Unit: 2872

24) having a surface (20) for placement of said excised tissue to restrain said tissue in said container against said surface (said tissue is restrained against 20) and imaging said excised tissue through at least part of said surface of said container. Since the apparatus disclosed by Henry is for preparing cells for microscopic inspection (first sentence of abstract), optics will inherently be directed towards the excised tissue through portion (24) of said tray.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Henry (USPN 3,904,781) in view of Ornstein et al (USPN 4,545,831).

Henry discloses an apparatus (Fig 1) for imaging excised tissue (column 2, lines 26-29) having a refractive index, tissue inherently has a refractive index. Henry also discloses a tray (24) with a means for clamping (column 3, lines 17-22) said tissue upon said tray and with optics directed towards the excised tissue through a portion of said tray, since the apparatus disclosed by Henry is for preparing cells for microscopic inspection (first sentence of abstract), optics will inherently be directed towards the excised tissue through portion of said tray. Henry lacks the immersion media having a refractive index matching the refractive index of said excised material. Ornstein discloses the immersion media (18 and 27, 18 and 27 are both curable polymer mediums and since they are to have the same refractive indexes, they can be of the same

Art Unit: 2872

material to form one immersion media) having a refractive index matching the refractive index (column 5, lines 23-26) of said excised material (9). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the index of refraction of the immersion medium of Henry to match the index of refraction of the excised tissue as disclosed by Ornstein to give a very high quality microscope image (Ornstein, column 5, lines 31-33).

Claim 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Henry in view of Ornstein as applied to claim 9 above, and further in view of Tomimatsu (USPN 5,870,223).

Henry in view of Ornstein discloses the invention except for an optical coupling means disposed between said tray and said optics which present a medium between said tray and said optics. Tomimatsu discloses an optical coupling means (47) disposed between said tray and said optics (Fig. 6B) which present a medium between said tray and said optics. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the tray of Henry in view of Ornstein to include an optical coupling means disposed between said tray and said optics as disclosed by Tomimatsu to eliminate spherical aberrations (Tomimatsu, column 1, lines 17-20 and lines 25-30).

Claim 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Henry in view of Ornstein as applied to claim 9 above, and further in view of Newman (USPN 1,991,983).

Henry in view of Ornstein discloses the invention except for having indicia applied to said tray for identification of said tissue disposed therein. Newman discloses indicia applied to said tray (Fig. 1 and Fig. 3) for identification of said tissue disposed therein. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

Art Unit: 2872

modify the tray of Henry in view of Ornstein to include indicia applied to said tray to help keep the specimens in order and easily tracked.

Claims 23 and 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Henry in view of Ornstein as applied to claim 9 above, and further in view of Foote (USPN 1,002,910).

Henry in view of Ornstein discloses the invention except for where the clamping means has a mesh or membrane capable of holding said excised tissue upon said tray. Foote discloses a clamping means that has a mesh (10 and column 2, lines 78-83 where the pliable sheet is cloth) or membrane (10 and column 2, lines 78-83 where the pliable sheet is paper) capable of holding said excised tissue upon said tray (Fig. 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the tray of Henry in view of Ornstein to make the clamping means a mesh or membrane as per the disclosure of Foote to be easily adaptable for clamping specimens of various shapes and sizes.

Claims 34 and 35 rejected under 35 U.S.C. 103(a) as being unpatentable over Henry in view of Foote (USPN 1,002,910).

Henry discloses the invention as set forth above except for where the restraining step is carried out with the aid of a mesh or membrane in said container. Foote discloses the restraining step being carried out with the aid of a mesh (10 and column 2, lines 78-83 where the pliable sheet is cloth) or membrane (10 and column 2, lines 78-83 where the pliable sheet is paper) in said container (Fig. 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the restraining step of Henry to be carried out with a mesh or membrane as per the disclosure of Foote to be easily adaptable for clamping specimens of various shapes and sizes.

***Allowable Subject Matter***

Claims 25-29 allowed. None of the references teach using a clamping member to directly hold down excised tissue specimen to viewing tray.

Claims 21,22 and 31-33 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Reasons for Allowance***

The following is an examiners statement of reasons for allowance:

Claims 25-29 are allowable and claims 21,22 and 31-33 have allowable subject matter for at least the reason that the prior art fails to teach and/or suggest "at least one clamp member extending into said container onto said excised tissue capable of restraining said excised tissue in position" as set fourth in the claimed combination.

Footnote, USPN 1,002,910, discloses a specimen mount (Fig. 1) with a pliable sheet but does not have any type of finger type member extending into the container to restrain the specimen as claimed.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jesse C Rowe whose telephone number is (703)305-7018. The examiner can normally be reached on Regular.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached on (703)308-1687. The fax phone numbers for the


Art Unit: 2872

organization where this application or proceeding is assigned are (703)305-7018 for regular communications and (703)305-7018 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-7018.

Jesse Rowe

July 29, 2002

  
Cassandra Spyrou  
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